

REMARKS

Summary of the Amendment

Upon entry of the above amendment, the claims 1-9 and 14-16 will have been amended and claims 18-21 will have been added. Accordingly, claims 1-21 will be pending with claims 1 and 6 being independent.

Summary of the Official Action

In the instant Office Action, the Examiner failed to acknowledge whether all some or none of the priority documents have been received in the parent application. The Examiner also objected to the specification and the claims as to minor formal matters. The Examiner additionally rejected claims 1-17 as containing new matter and as indefinite and indicated that these claims contain allowable subject matter and would be allowable if written to overcome the formal rejection. Finally, claims 3, 6 and 7 were rejected as non-enabling. By the present amendment and remarks, Applicant submits that the objections and rejections are improper and/or are overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Acknowledgment of Allowable Subject Matter

Applicant acknowledges and appreciates the Examiner's indication that claims 1-17 contain allowable subject matter and would be allowable if amended to overcome the formal

objections and rejections. Accordingly, as Applicant has addressed the various objection and rejections in an manner which resolves them, Applicant requests that claims 1-17 be indicated to be allowed.

Traversal of Objection to the Specification

Applicant submits that the Examiner's objection to the specification as containing new matter is improper because paragraphs [0029], [0031] and [0033]-[0035] of the instant specification correspond to the claims. That is, these paragraphs were added to the continuation application to provide antecedent support for the claims and include the same language used in the claims. For Example, paragraph [0029] corresponds to claim 1 of the instant application, paragraph [0031] corresponds to claim 3, and paragraphs [0033]-[0035] correspond to claims 6-14.

Furthermore, the language used in these paragraphs and claims find support in the parent application 08/955,920 (Attorney Docket No. P16090.S01). For the Examiner's convenience, a copy of this application is attached to this Amendment.

Specific support for such language can be found in P16090.S01 between page 3, line 9 and page 9, line 30. However, to assist the Examiner, Applicant will describe wherein each recited feature can be found in the parent application. This will be fully explained with reference to the section 112, first paragraph rejection.

In view of the above and the discussion which follows, Applicant requests that the Examiner reconsider and withdraw the objection to the specification.

Objection to the Claims is moot

Applicant submits that the Examiner's objection to the claims is moot because claim 5 has been amended to overcome this objection. Support for the amendment to claim 5 can be found in the parent application on, e.g.: page 3, lines 5-6, 10-11, 18-21; page 4, lines 2, 10-12, 16-18; page 5, line 29; page 6, line 7; page 7, line 21-23; page 10, lines 1-2, 15-16, 22-25; and in particular, page 8, lines 1-6 which specifically explains that the fibers can be oriented both in the circumferential direction and in the axial direction. Additional support can be found in, e.g., Fig. 2.

In view of the above, Applicant respectfully requests that the Examiner reconsider and withdraw the objection to the claims.

Traversal of Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-17 were rejected under 35 U.S.C. § 112, first paragraph, as containing new matter.

Throughout this rejection, the Examiner asserts that certain recited features lack support in the specification. The Examiner specifically explains that Applicant has not specifically pointed out wherein one can find specific support in the specification for each feature recited in the claims. Applicant respectfully disagrees that the specification lacks support for the recited features. However, to assist the Examiner in this regard, Applicant will herein point out the specific locations in the parent application (P16090.S01), upon

which the instant application is based, wherein the features recited in the claims find support. Applicant submits that the description of the parent application is specifically recited in the instant application, which was expressly incorporated by reference. Applicant also submits that no new matter has been added to the instant specification, as will be demonstrated herein with specific reference to the parent application for each claim.

Support for claim 1 can be found in the parent application on, e.g.: page 3, lines 5-6, 10-11, 18-21; page 4, lines 2, 10-12, 16-18; page 5, line 29; page 6, line 7; page 7, line 21-23; page 8, lines 1-6; and page 10, lines 1-2, 15-16, 22-25, wherein it explains how orienting the layer of fibers in the circumferential direction provides tensile strength to the insert to resist centrifugal forces. Note that, e.g., page 8, lines 12-14 specifically indicates that the mesh can be attached by wrapping - a description which clearly and inherently supports language designating this as a layer. With regard to the assertion that the specification lacks support for the support element being "coupled" to the insert, Applicant directs the Examiner's attention to page 3, lines 29-30, page 5, lines 5-6, page 7, lines 25-29, and in particular, page 8, lines 12-14 which specifically explains that support element (i.e., woven mesh) "can be attached to the foamed material ring 5". See also page 8, lines 20-21 for how such attachment can be accomplished. See also page 8, lines 23-24 and Fig. 2.

Support for claim 2 can be found in the parent application in, e.g., Fig. 1 and between page 3, line 29 and page 4, line 1 of the parent specification.

Support for claim 3 can be found in the parent application in, e.g., Figs. 3 and 3A, and on page 4, lines 4-5, page 9, lines 25-30, and page 10, lines 9-10 of the parent specification.

Support for claim 4 can be found in the parent application on, e.g., page 4, lines 14-16 of the parent specification.

Support for claim 5 can be found in the parent application in, e.g., Fig. 2 and on page 4, lines 16-18, page 7, lines 25-30 and page 8, lines 1-6 of the parent specification.

Support for claims 6 and 7 can be found in the parent application on, e.g., page 4, lines 20-23, page 9, lines 9-14 of the parent specification. Note that the foil is disclosed as an alternative to a woven mesh, and that page 9, lines 13-14 specifically indicates that the foil can be mounted to the insert ring in an "analogous" manner, e.g., in a layer or layers.

Support for claim 8 can be found in the parent application in, e.g., each figure and on page 4, lines 25 and, in particular page 4, line 29 and page 8, line 18 of the parent specification.

Support for claim 9 can be found in the parent application in, e.g., Figs. 3 and 3A, and on page 9, lines 25-30, and on page 10, lines 1-16 of the parent specification.

Support for claims 10 and 11 can be found in the parent application in, e.g., Figs. 3 and 3A, and on page 10, lines 1-13 of the parent specification.

Support for claim 12 can be found in the parent application in, e.g., Figs. 3 and 3A, and on page 10, lines 1-13 as well as between page 4, line 29 and page 5, line 6 and on page

8, lines 20-21 of the parent specification.

Support for claim 13 and 14 can be found in the parent application in, e.g., Figs. 3 and 3A, and on page 4, lines 29-30, page 5, lines 1-3, page 9, lines 25-30 as well as page 10, lines 1-16 of the parent specification.

Support for claim 15 can be found in the parent application on, e.g., page 5, lines 9-11 of the parent specification.

Support for claim 16 can be found in the parent application on, e.g., page 3, lines 9-11, 18-21, 23-25, page 4, lines 1-2, 16-18, page 5, lines 11-13, 29, page 6, lines 7, 21-23, page 8, lines 1-6, and in particular on page 10, lines 15-16 and 22-25 of the parent specification.

Support for claim 17 can be found in the parent application in, e.g., Fig. 1, and on page 5, lines 11-13, page 7, lines 1-3, page 7, line 30, page 9, line 1, as well as page 9, lines 16-18 and 20-30 and page 10, lines 25 of the parent specification.

Finally, support for new claims 18-21 can be found in the parent application on, e.g., page 7, lines 1-10 of the parent specification.

Thus, it is believed that each issue indicated by the Examiner has been addressed. Accordingly, the rejection has been rendered moot and the Examiner is requested to withdraw the new matter rejection.

Traversal of Rejection under 35 U.S.C. § 112, first paragraph

Claims 3, 6 and 7 were rejected under 35 U.S.C. § 112, first paragraph, as being non-enabled.

As discussed above, support for claim 3 can be found in the parent application in, e.g., Figs. 3 and 3A, and on page 4, lines 4-5, page 9, lines 25-30, and page 10, lines 9-10 of the parent specification. Applicant notes that page 9, lines 27-28 specifically recites “several layers” and that Fig. 3 shows 4 layers. Moreover, support for claims 6 and 7 can be found in the parent application on, e.g., page 4, lines 20-23, page 9, lines 9-14 of the parent specification. Note that the foil is disclosed as an alternative to a woven mesh, and that page 9, lines 13-14 specifically indicates that the foil can mounted to the insert ring in an “analogous” manner, e.g., in a layer or layers.

Rejection under 35 U.S.C. § 112, second paragraph, is moot

Claims 1-17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

By this amendment, Applicant has amended each claim consistent with the Examiner’s suggestions. Applicant disagrees with most of the Examiner’s assertions because most of the claims are not unclear or indefinite. However, in an effort to advance prosecution, Applicant has adopted all of the Examiner’s suggested changes so that the application can proceed to issue.

Thus, it is believed that each issue indicated by the Examiner has been addressed. Accordingly, the rejection has been rendered moot and the Examiner is requested to withdraw the indefiniteness rejection.

Comments on Reasons for Allowance

In response to the Statement of Reasons for Allowance set forth in the Office Action, Applicant wishes to clarify the record with respect to the basis for the patentability of the indicated claims in the present application. In this regard, while Applicant does not disagree with the Examiner's indication that certain identified features are not disclosed by the references, Applicant submits that the claims in the present applicant recite a combination of features, and that the basis for patentability of these claims is based on the totality of the recited features.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicant's invention, as recited in each of claims 1-21. The claims have been amended to eliminate any arguable basis under section 112, second paragraph.

Further, any amendments to the claims which have been made in this response and

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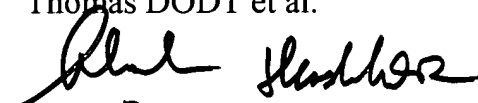
which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to credit any overpayment or charge any additional fee to Deposit Account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,
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Attachment: Appendix
Copy of P16090.S01

APPENDIX

Changes to claims 1-9 and 14-16 as follows:

1. (Amended) A motor vehicle wheel comprising:

a wheel rim;

a tire having a tire interior enclosed by the wheel rim and the tire;

the tire being mounted on the wheel rim;

an insert comprising [of] a ring-shaped sound-absorbing material;

the insert being positioned within the tire interior;

an acoustically transparent support element comprising at least one layer of fibers oriented in a circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction; and

the acoustically transparent support element being coupled to the insert.

2. (Amended) The motor vehicle wheel in accordance with claim 1, the insert having a surface [arranged to be] open to the tire interior at least over a portion of its cross-section; and

the acoustically transparent support element [being adapted to wrap] wrapping the surface of the insert.

3. (Amended) The motor vehicle wheel in accordance with claim 1, the acoustically transparent support element comprising a plurality of support [elements] element layers radially arranged within the insert at discrete distances from each other.

4. (Amended) The motor vehicle wheel in accordance with claim 1, the acoustically transparent support [elements] element comprising a woven mesh.

5. (Amended) The motor vehicle wheel in accordance with claim 4, the woven mesh comprising fibers with tensile strength and extending in [the circumferential] an axial direction of the tire.

6. (Amended) [The motor vehicle wheel in accordance with claim 1, the acoustically transparent support element being a perforated foil] A motor vehicle wheel comprising:

a wheel rim;

a tire having a tire interior enclosed by the wheel rim and the tire;

the tire being mounted on the wheel rim;

an insert comprising a ring-shaped sound-absorbing material;

the insert being positioned within the tire interior;

an acoustically transparent support element comprising at least one layer of perforated foil oriented in a circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of perforated foil oriented in the circumferential direction; and

the acoustically transparent support element being coupled to the insert.

7. (Amended) The motor vehicle wheel in accordance with claim 6, the foil being [formed in an] isotropic [manner].

8. (Amended) The motor vehicle wheel in accordance with claim 1, the insert being [formed as] a closed ring.

9. (Amended) The motor vehicle wheel in accordance with claim 8, the closed ring comprising a strip of [sound-reducing] sound-absorbing material [adapted to be] wrapped several times in a ring-like manner.

14. (Amended) The motor vehicle wheel in accordance with claim 13, the acoustically transparent support element comprising a plurality of support element layers; and
at least one of the support element layers is positioned between [each] adjacent radially arranged insert [layer] layers.

15. (Amended) The motor vehicle wheel in accordance with claim 1, the insert comprising a plurality of circumferential segments [being adapted to be] joined after assembly.

16. (Amended) The motor vehicle wheel in accordance with claim 1, the acoustically transparent support element [being adapted to add] adding, at least in the circumferential direction, tension to the sound-absorbing insert.